REMARKS

I. INTRODUCTION

In response to the Office Action dated July 27, 2005, claims 1, 4, 6, 10, 11, 15, 18, 20, 24, 25, 29, 32, 34, 38, and 39 have been amended, claims 44, 46, 48, 50, 52, and 54 have been cancelled, claims 55-60 have been added. Claims 1, 3-11, 13-15, 17-25, 27-29, 31-39, and 41-43, 45, 47, 49, 51, 53, and 55-60 remain in the application. Entry of these amendments, and re-consideration of the application, as amended, is requested.

II. PRIOR ART REJECTIONS

In paragraphs (1)-(3) of the Office Action, claims 1, 3-9, 11, 13-23, 25, 27-37, 39, and 41-42 were rejected under 35 U.S.C. §102(e) as being anticipated by Aravamudan et al. (Aravamudan), U.S. Patent No. 6,301,609. In paragraph (5) of the Office Action, claims 10, 24, and 38 were rejected under 35 U.S.C. §103(a) as being unpatentable over Aravamudan in view of Godlewski, U.S. Patent No. 6,421,354. In paragraph (6) and (7) of the Office Action, claims 43-54 were rejected under 35 U.S.C. §103(a) as being obvious in view of the combination of Aravamudan and Larkins, U.S. Patent No. 6,295,291.

Specifically, claims 1, 11, 15, 25, 29, and 39 were rejected as follows:

> As to claim 1, Aravamudan teaches a method for enabling cellular instant messaging comprising (abstract, figs. 1-9):
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> receiving a telemetry message that comprising a remote feature activation message wherein telemetry message indicates the availability on a cellular network of a first cellular phone (col. 7, line 15-col. 8, line 4);
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> storing information regarding the first cellular phone in an instant messaging database, wherein the information comprises a buddy list (col. 4, lines 30-45, col. 6, lines 10-30, col. 9, lines 55-65); and
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> transmitting a browser alert to one or more relevant buddies identified in the buddy list (col. 7 lines 1-40, col. 8, lines 35-45, col. 8, line 60-col. 9, line 25).
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> Regarding claim 11, Aravamudan teaches a method for enabling cellular instant messaging comprising (abstract):
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> transmitting, from a first cellular phone, a telemetry message comprising a remote feature activation message wherein telemetry message indicates the first cellular phone's availability on a cellular network (col. 6, lines 10-45, col. 7, line 15-col. 8, line 4, col. 9, lines 55-65);
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> receiving a browser alert, on the first cellular phone, indicating availability of buddies on a buddy list of the first cellular phone (col. 7, lines 1-40, col. 8, lines 35-45, col. 8, line 60-col. 9, line 25).
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> Regarding claim 15, Aravamudan teaches a system for enabling cellular instant messaging comprising (abstract, figs. 1-9):

an instant messaging database configured to maintain information regarding a first cellular phone, wherein the information comprises a buddy list (col. 4, lines 30-45, col. 6, lines 10-30, col. 9, lines 55-65);

a cellular network; and a server configured to:

receive a telemetry message comprising a remote feature activation message from a cellular phone wherein telemetry message indicates the availability of the first cellular phone on the cellular network (col. 7, line 15-col. 8, line 4); and

transmit a browser alert to one or more relevant buddies identified in the buddy list (col. 7, lines 1-40, col. 8, lines 35-45, col. 8, line 60-col. 9, line 25).

Regarding claim 25, Aravamudan teaches a system for enabling cellular instant messaging comprising a first cellular phone configured to (abstract):

transmit a telemetry message comprising a remote feature activation message wherein telemetry message indicates the first cellular phone's availability on a cellular network (col. 6, lines 10-45, col. 7, line 15-col. 8, line 4, col. 9, lines 55-65).

Regarding claim 29, Aravamudan teaches an article of manufacture comprising a program storage medium readable by a computer hardware device and embodying one or more instructions executable by the computer hardware device to perform a method for enabling cellular instant messaging, the method comprising (abstract):

receiving a telemetry message comprising a remote feature activation message wherein telemetry message indicates the availability on a cellular network of a first cellular phone (col. 7, line 15-col. 8 line 4);

storing information regarding the first cellular phone in an instant messaging database, wherein the information comprises a buddy list (col. 4, lines 30-45, col. 6, lines 10-30, col. 9, lines 55-65); and

transmitting a browser alert to one or more relevant buddies identified in the buddy list (col. 4, lines 30-45, col. 6, lines 10-30, col. 9, lines 55-65).

Regarding claim 39, Aravamudan teaches an article of manufacture comprising a program storage medium readable by a computer hardware device and embodying one or more instructions executable by the computer hardware device to perform a method for enabling cellular instant messaging, the method comprising (abstract):

transmitting, from a first cellular phone, a telemetry message comprising a remote feature activation message wherein telemetry message indicates the first cellular phone's availability on a cellular network (col. 6, lines 10-45, col. 7, line 15-col. 8, line 4, col. 9, lines 55-65);

receiving a browser alert, on the first cellular phone, indicating availability of buddies on a buddy list of the first cellular phone (col. 7, lines 1-40, col. 8, lines 35-45, col. 8, line 60-col. 9, line 25).

In addition to the above, prior dependent claims 44, 46, 48, 50, 52, and 54 (whose subject matter has been added to the independent claims) were rejected as follows:

Regarding claims 43-54 Aravamudan et al teaches a client subscribing to the Communication Services Platform with Instant Messaging Service has an incoming voice call. The incoming call is directed to the client's Communication Services Platform. The services executive 164 directs the network as to how it should proceed with the voice call. The services executive 164 maintains a plurality of rules and real term events which may, for example, direct the network services interface 162 to complete the voice call to a particular phone number, or it may determine that the voice call should be directed to a particular e-mail address, or it may determine that the voice call should be placed on hold while attempts are made to locate the present location and interface over which the client may be reached (col. 5, lines 52-67). Aravamudan et al does not specifically teach as a roaming cellular phone desiring to activate/deactivate a feature.

> In an analogous art, Larkins teaches a roaming cellular phone desiring to activate/deactivate a feature (col. 5, line 66-col. 6, lines 13)). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Aravamudan et al by specifically adding feature roaming cellular phone in order to enhance system performance, enables to provide various feature from the service provider for roaming mobile terminals as taught by Larkins.

Applicant traverses the above rejections for one or more of the following reasons:

(1) Neither Aravamudan, Godlewski, nor Larkins teach, disclose or suggest using a remote feature activation message to initiate, utilize, or as part of an instant messaging system; and

(2) Neither Aravamudan, Godlewski, nor Larkins teach, disclose or suggest a remote feature activation message sent by a cellular phone that is interpreted by a cellular network as a roaming phone desiring to activate/deactivate a feature, which is used to store information utilized in an instant messaging application.

Independent claims 1, 11, 15, 25, 29, and 39 are generally directed to an invention that enables cellular phone instant messaging. The amended independent claims provide for a telemetry message that is in the form of a remote feature activation message. The remote feature activation message is transmitted from the cellular phone. Further, remote feature activation messages are specific types of messages as described in the application on page 8, line 10-page 9, line 4. The specific types/forms of remote feature activation messages are also specifically claimed limitations for the independent claims. In this regard, the remote feature activation message is interpreted by the cellular network as a roaming cellular phone desiring to activate/deactivate a feature. However, instead of activating/deactivating a feature, the message is used to store information (e.g., a buddy list) regarding the cellular phone in an instant messaging database transmitting a browser alert to buddies in the buddy list. Thus, the cellular network enables the instant messaging by interpreting the telemetry message as a remote feature activation message.

It should also be noted that the new dependent claims (i.e., claims 55-60) provide that the cellular network routes the remote feature activation message to the cellular phone's home cellular network. Such routing enables an instant messaging application on the cellular phone's home network to provide for the instant messaging.

Additional dependent claims set forth limitations regarding the telemetry message including that the message may be data encoded in a dialed digits field of a message. As described in the specification, such a message may be in the form of a fictitious area code preceded by the star character (*). The message is interpreted by the cellular network as identifying a roaming cellular phone that

desires to activate/deactivate a feature (e.g., call forwarding, call waiting, etc.). Accordingly, the message is transmitted to the cellular phone's home cellular network. The home cellular network interprets the message as being available on a cellular network for purposes of instant messaging. Thus, the remote feature activation message for use in instant messaging is handled by the cellular network similar to standard remote feature activation messages. Yet the remote feature activation of the present invention enables cellular instant messaging.

In view of the above, Applicants note that a significant advantage of the present invention that is set forth in the claims is the use of the remote feature activation message to enable the cellular instant messaging. In this regard, in response to the receipt of the remote feature activation message (as part of the telemetry message), information for instant messaging is stored in a database and used to transmit information to buddies in a instant messaging buddy list. The unique ability to use remote feature activation messages to enable instant messaging is not even remotely disclosed in any of the cited references.

Aravamudan merely describes a unified messaging solution and services platform that utilizes the features and capabilities associated with instant messaging to locate a registered user, query the user for a proposed message disposition, and coordinate services among a plurality of communication devices, modes, and channels. A user proxy is registered to the user as a personal communication services platform. The user is able to define various rules for responding to received data and communications, the rules stored within a rules database servicing the communication services platform. Instant messaging is used for communications between the user and the communication services platform's user proxy (see Abstract).

However, as admitted in the Office Action, Aravamudan fails to teach the interpretation of the remote feature activation message as a roaming cellular phone desiring to activate/deactivate a feature. To teach this aspect of the prior dependent claims, the Office Action relies on Larkins. Applicants first note that Larkins describes the use of a desktop computer accessing the Internet to set up various features for a radiotelephone (see Abstract and col. 6, lines 47-56). Thus, contrary to a cellular phone transmitting a remote feature activation message (as claimed), Larkins describes the process of using a computer to access the Internet and setup a feature. In addition, there is no capability, explicit or implicit, in Larkins that even remotely suggests a cellular network interpreting a message from a cellular phone as a roaming telephone desiring to activate/deactivate a feature. The

Office Action relies on col. 5, lines 66-col. 6, line 13. However, this portion of Larkin merely describes using an "update profile" button on a web page using a computer. Such a teaching is not even remotely similar to the specific limitations claims regarding a roaming cellular phone.

In view of the above, Applicants submit that Larkin clearly fails to teach, disclose, suggest, or allude to a remote feature activation message in any way, shape, or form. In addition, Applicants submit that the claims and their steps must be viewed as a whole and how the steps interrelate to each other. While Applicants submit that one cannot show non-obviousness by attacking references individually where the rejections are based on combinations of references, the claimed invention must be examined as a whole and whether the "whole" claimed invention would have been obvious at the time of invention (see MPEP §2142). In addition, under MPEP §706.02(j) "there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings."

Accordingly, the various claims elements must be viewed together as a whole. Specifically, with reference to claim 1, the first step provides for receiving the telemetry message in a cellular network from a cellular phone. Further, the telemetry message is interpreted as a remote feature activation message such that the cellular network views the cellular phone as a roaming phone desiring to activate/deactivate a feature. In response to the message, information for the instant messaging is stored in a database and then used to transmit information to buddies identified in a buddy list. Thus, the unique combination of the elements provides for using the telemetry message and remote feature activation message to enable instant messaging. Such a claim limitation is not even remotely hinted at by the references, either alone or in combination. In this regard, even assuming that Larkins teaches the roaming cellular phone aspect of the claims (which Applicants traverse as described above), Larkins still fails to teach the use of such a remote feature activation message as part of an instant messaging application or to enable an instant messaging application. Aravamudan also fails to suggest such a combination. In fact, there is no hint, suggestion, or motivation to combine Aravamudan with Larkins to provide the claim limitations or the results as set forth in the claims.

The MPEP provides that there must be a suggestion or motivation to modify the references to produce the claim limitations. There is no suggestion or motivation to combine the references as

asserted in the Office Action. The motivation cited in the Office Action is to enhance system performance. All systems and programs desire to enhance system performance. However, such a broad desire does not and cannot rise to the level of motivation required in the MPEP for combining Aravamudan with Larkins as asserted in the Office Action.

In view of the above, Applicants submit that the references cannot be combined and even if combined, they still fail to teach the invention and specifically claimed limitations. Further, the various elements of Applicant's claimed invention together provide operational advantages over the systems disclosed in Aravamudan, Godlewski and Larkins. In addition, Applicant's invention solves problems not recognized by Aravamudan, Godlewski and Larkins.

Thus, Applicant submits that independent claims 1, 11, 15, 25, 29, and 39 are allowable over Aravamudan, Godlewski and Larkins. Further, dependent claims 3-10, 13, 14, 17-24, 27, 28, 31-38, 41-43, 45, 47, 49, 51, 53, and 55-60 are submitted to be allowable over Aravamudan, Godlewski and Larkins in the same manner, because they are dependent on independent claims 1, 11, 15, 25, 29, and 39, respectively, and because they contain all the limitations of the independent claims. In addition, dependent claims 3-10, 13, 14, 17-24, 27, 28, 31-38, 41-43, 45, 47, 49, 51, 53, and 55-60 recite additional novel elements not shown by Aravamudan, Godlewski and Larkins.

III. CONCLUSION

In view of the above, it is submitted that this application is now in good order for allowance and such allowance is respectfully solicited. Should the Examiner believe minor matters still remain that can be resolved in a telephone interview, the Examiner is urged to call Applicant's undersigned attorney.

Respectfully submitted,

David W. Kelleher

By their attorneys,

GATES & COOPER LLP

Howard Hughes Center
6701 Center Drive West, Suite 1050
Los Angeles, California 90045
(310) 641-8797

Date: September 26, 2005

By: _____

Name: Jason S. Feldmar

Reg. No.: 39,187

JSF/bjs